The Examiner rejects claims 11-19 under both 35 USC §112 and 35 USC §101. The Examiner contends that claim 11 and claims dependent thereon "is an improper hybrid of two of the four separate statutory classes of invention (method and apparatus)." The Examiner's contention is believed mistaken, and as confirmed by the Patent Office Board of Patent Appeals and Interferences in the case of *Ex parte Porter*, 25 USPQ2d 1144, 1147 (BOPAI 1992), such claims are perfectly proper and meet all statutory requirements.

Specifically, applicants' claim 11 recites an apparatus for carrying out the method of claim 1 and then specifies some elements of that apparatus. In the similar case reported in *Ex parte Porter*, the Board of Appeals confirmed that a method claim could be dependent from and incorporate the subject matter of an apparatus claim and vice versa. The Board concluded that this manner of claim drafting "has been an acceptable format for years" and also confirmed that the Manual of Patent Examining Procedure (Section 608.01(n)) confirms that such claims are proper dependent claims. The Board also confirmed that the claim is definite under the fourth paragraph §112.

Accordingly, in view of the more recent precedent of the *Porter* case, the Examiner's rejection of claim 11 and claims dependent thereon as being an allegedly improper hybrid is an incorrect application of MPEP Section 2173.05(p). Applicants have reviewed this section and the *Ex parte Lyell* case cited as support. Applicants note that *Ex parte Porter* post-dated the *Ex parte Lyell* decision by the Board and therefore to the extent that *Lyell* is inapposite to *Ex parte Porter*, it is no longer the position of the

Board of Appeals. Applicants rely upon the Board's decision in *Ex parte Porter* and requests that the Examiner reconsider his rejections under 35 USC §112 and 35 USC §101.

Claim 11 is clearly directed to an apparatus, and the reference to claim 1 is an indication of the method in which the apparatus is utilized. Any further rejection of claims 11-19 is respectfully traversed.

Claims 1-10 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent 5,619,327. Reconsideration of this rejection is respectfully requested. Applicants' method claim 1 in the present application recites at least two method steps not disclosed or rendered obvious by the '327 patent, i.e. the steps of

> "providing a range of calibration samples of structurally equivalent members, the samples each having been subject to the known type of stress to a differing respective degree"

and

> "measuring the extent of a said region of distortion and comparing the said measurement with equivalent measurements taken for respective calibration samples to determine the degree of stress applied to the member."

The Examiner is respectfully requested to point out where he believes that either of these method steps are disclosed or rendered obvious in the '327 patent. Applicants contend that they are not disclosed, and therefore there is no reason why one would seek to

modify the method of claim 1 in the '327 patent in the manner of the presently recited claim 1.

Accordingly, there is no basis for alleging that claim 1 of the '327 patent covers the same subject matter of claim 1 in the present application. They are clearly patentably distinct, and the Examiner has not pointed out where there is any disclosure in the issued patent for either of the method steps in the present claim 1 noted above. Accordingly, reconsideration of the rejection of claims 1-10 is respectfully requested.

The Examiner's failure to cite any prior art in conjunction with a rejection on the merits is very much appreciated, as is his consideration of the most pertinent known art cited by applicants in applicants' Information Disclosure Statements. Based upon the failure to cite any prior art against the claims, applicants presume that, but for the above rejections, all claims are patentable over the examined prior art.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-19 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact applicants' undersigned representative.

Respectfully submitted,

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